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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,601	07/06/2001	Takashi Azuma	Q65349	4065

7590 10/23/2003
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

FORTUNA, JOSE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/899,601	AZUMA ET AL.
	Examiner	Art Unit
	José A Fortuna	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 July 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 7-22 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6, 23-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-6 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasushi, JP 200-63802, (JP0 Machine translation has been used).

Yasushi teaches a method making a discontinuous body, in which a fibrous material is fed to water that is in stirred condition and then the slurry is passed through a wire cloth while the stirring condition is maintained, see figure 2. Figure 2 also shows the plurality of stirring mechanism of claims 2-3. Even though Yasushi does not explicitly teach cleaning of the stirred tanks, this is what is normally done, i.e., cleaning the device after use. Even though Yasushi is silent with respect to the dilution of the pulp in stirred water, this would fall within the levels of ordinary skill in the art if the incoming pulp needs or is desired to be diluted. Note also that one of ordinary skill in the art would have reasonable expectation of success if the pulp is diluted to desired levels in the stirring tanks of the reference. Claims are unpatentable when they are so broad as to read on obvious subject matter even though they likewise read on non-obvious subject matter. *In re Mraz*, 455 F2d 1069: 173 USPQ 25 (CCPA 1976). *In re Muchmore*, 433 F2d 824; 167 USPQ 681 (CCPA 1970).

Regarding claim 4, Yasushi does not teach air nozzles as the stirring mechanism. However, Yasushi teaches the stirring of the slurry with equivalent mechanisms and it has been held that, [W]here two equivalents are interchangeable for their desired function, substitution would have been obvious and thus, express suggestion of desirability of the substitution of one for the other is unnecessary." *In re Fout* 675 F. 2d 297, 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 372 F.2d 566, 152 USPQ 618 (CCPA 1967). One of ordinary skill in the art would find the substitution of the different mechanisms obvious, absent a showing of unexpected results.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by TAPPI test Method T 205 Om-81

The TAPPI test shows the making of handsheets where it is shown that fibers are mixed with water to form an slurry which can be further diluted in water while stirring and then put on a wire, pressed and then dried, see procedures and sheetmaking in page 2. Note that it has been held that “[A] preamble is not a limitation if it merely states a purpose or intended use and the remainder of the claim completely defines the invention.” See Diversitech Corp. vs. Century Steps Inc., 7 USPQ 2d 1315 (Fed. Cir. 1988).

Response to Arguments

6. Applicant's arguments with respect to claims 1-6 and 23-24 have been considered but are moot in view of the new ground(s) of rejection.
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Making discontinuous paper bodies."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A Fortuna whose telephone number is 703-305-7498. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 703-308-1164. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0662.


José A Fortuna
Primary Examiner
Art Unit 1731

JAF